

REMARKS

The Amendment:

Claim 1 has been amended to restore the “direct image array” term which was in the claim as presented in the Amendment A submitted on July 7, 2004, but was inadvertently omitted from the claim in the listing of claims submitted on August 10, 2004. The claim has also been amended to recite that the top coat of the pressure sensitive adhesive overlies the direct image array.

Claim 2 has been redrafted in independent form indication of allowable subject matter in paragraph 8 of the last Office action.

The Rejections:

Claims 1,2, 6-8 and 16-24 were rejected under 35 USC § 112 as failing to comply with the enablement requirement.

Claims 1, 2, 6-8 and 16-24 were rejected under 35 USC § 112 as indefinite for failing to particularly point out and distinctly claim the invention.

Claims 1, 7, 8, 16, 18, 19 and 22-24 were rejected under 35 USC § 103(a) as unpatentable over Katsura et al in view of Noguchi et al.

Applicant's Comments:

The 35 USC § 112 Rejections:

The rejection for lack of enablement is inappropriate since applicants have included a specific example using specific materials with identified transition (melting) temperatures in a molding process using polyethylene molding resin with values of molding and demolding temperatures stated in the example.

In most of the decisions supporting a rejection for lack of enablement, complex and unpredictable chemical or biological phenomena are involved which require undue experimentation to select operative elements. As stated by the appellate court, “Enablement is not precluded by the necessity for some experimentation such

as routine screening. However, experimentation needed to practice the invention must not be undue experimentation. The key word is 'undue', not 'experimentation.'" *In re Wands* 8 USPQ 2d 1400, 1404 (Fed. Cir.). Decisions in which lack of enablement was found because of undue experimentation include *White Consol. Indus., Inc. V. Vega Servo-Control, Inc.*, 713 F.2d 788, 790-92; 218 USPQ 961 (Fed.Cir. 1983) in which 18 months to 2 years of experimentation were required; and *In re Ghiron*, 442 F.2d 985, 992; 169 USPQ 723, 727-28 (CCPA 1971) in which many months or years of experimentation required .to practice the patented invention

In this instance, routine screening of pressure sensitive adhesives for melting point temperatures and compatibility with the polyolefin resin used to mold the polyolefin object is not complex nor does it require lengthy experimentation.

The examiner has stated that the claims fail to particularly point out and distinctly claim the subject matter because they merely set forth physical characteristics. But the physical characteristics are at the essence of the invention, since it is the melting points and adhesive characteristics which enable the invention; i.e., the top coat adhesive is not adhesive at ambient temperatures and accordingly does not stick to adjacent transfers, but becomes adhesive at the elevated, demolding temperature so that it binds the transfer to the hot inside wall of the mold. Similarly, all the coats melt at the molding temperature so that they can transfer from the mold into the wall of the part formed in the mold. Reconsideration and removal of the 35 USC §312 rejections is respectfully requested.

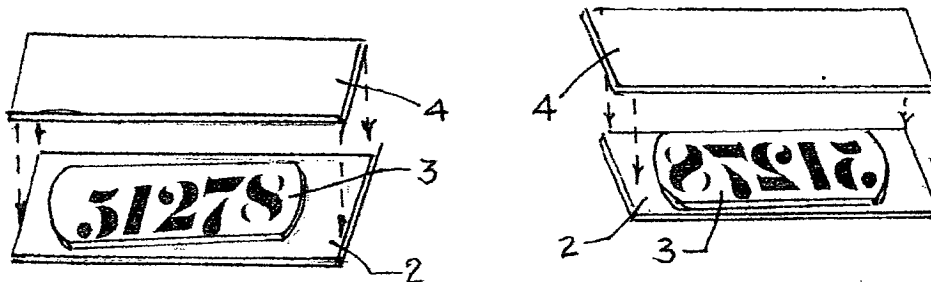
The 35 USC §103 Rejection:

Katsura et al discloses a label suitable for application to a container in a blow molding operation. In this respect, this patent is similar to the Brandt (3,108,850) patent cited in the second Office action dated 12/24/2002 of this application. Katsura et al, however, discloses the use of a hot melt adhesive layer 4 on the label. The adhesive layer 4, however, is not a top layer, but instead, is used to bond the label to

the plastic part formed during the blow molding; see column 7, lines 54-56. Applicants' claims recite a top layer that overlies the direct-image array of indicia. That is not suggested by Katsura et al. The following sketches illustrate the differences between the adhesive layer 5 of Katsura et al and applicant's top layer.

Applicant

Katsura et al



In Applicants' invention, the adhesive layer 4 overlies the direct image indicia layer 3 which is printed on the carrier sheet 2 so that the adhesive layer binds the indicia layer to the inside wall of the rotational mold.. In the application of applicants' transfer, the carrier sheet 2 is removed after the adhesive and indicia layers are glued to the hot surface of the mold.

In Katsura et al, the adhesive layer overlies a mirror image indicia layer so that it can bind the indicia layer to the molded part (bottle). Katsura et al secure their label in the blow mold by using a reduced pressure suction head; see column 8, lines 41-44, and the plastic film substrate 2 is located on the outer side and the hot-melt adhesive resin layer 4 is located on the inner side; column 8, lines 44-47. Alternatively, static electricity could be used to temporarily secure the label in the mold.

Naguchi et al has been cited for its disclosure of a wax containing ink. Noguchi et al discloses that ink jet printing on paper includes solvent inks which contain a dye and a "solid component like a wax and a polymeric component". The purpose of including wax in the ink composition is to prevent running and strike through of the ink, which is described as occurring when an organic solvent ink permeates too rapidly into the paper substrate; see column 2, lines 4-6. That an ink

SER. NO. 09/862,542

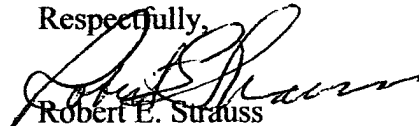
Amendment B

containing wax is useful in ink jet printing does not suggest the use of such ink for a completely unrelated application, i.e., in a transfer, particularly a transfer which is printed on a plastic film, not on paper.

In summary, the claimed invention is not suggested by the prior art in a manner which would render it obvious to one of ordinary skill in the art. Reconsideration of the prior art rejection is respectfully requested.

The claims are believed to be in proper form and, for the reasons set forth herein, define invention over the prior art. Reconsideration of the final rejection and allowance is respectfully requested. In the event that the examiner maintains the final rejection, it is requested that the amendment be entered for purposes of appeal as it obviates the issue that the claims are not commensurate with the arguments which applicants have previously advanced in this application.

Respectfully,



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